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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,448	02/15/2005	Veronique Ferrari	05725.1371	3680

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EXAMINER

POCHAS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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4121

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04/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/502,448	Applicant(s) FERRARI ET AL.	
	Examiner Christopher Pochas	Art Unit 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-83 is/are pending in the application.
- 4a) Of the above claim(s) 40,51-59 and 78-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-39, 41-50 and 60-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/9/2005, 10/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Office Action

1) Applicant's election with traverse of group I, claims 35-77 in the reply filed on 3/27/2009 is acknowledged. The traversal is on the ground(s) that the present claims share the common technical relationship of a composition comprising the elements set forth in claim 35. Applicant also argues that the technical feature (the composition of pending claim 35) is common to all the groups however this point is not in contention. This composition is obviated by the prior art as is discussed below. As a result, this argument is not found persuasive because the shared technical feature does not involve an inventive step and therefore is not "special" within the meaning of PCT rule 13.2 and the groups therefore lack unity.

2) Claims 78-83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/27/2009.

3) Applicant's election with traverse of a semi-crystalline polymer and an ester in the reply filed on 3/27/2009 is acknowledged. The traversal is on the ground(s) that The examiner merely asserts a conclusionary statement. This is not found persuasive because semi-crystalline polymers and esters are not novel, they are present in the prior art cited below.

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4) Claims 40 and 51-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/27/2009.

5) This application is a 371 application of PCT/FR02/03802 which claims priority to French applications 02/00885 and 02/02358. French application 02/00885 has been submitted and is in compliance, however 02/02358 has not.

Non Final Rejection

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The term "sparingly" in claim 68 is a relative term which renders the claim indefinite. The term "sparingly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A single example is given of a sparingly polar oil in the instant specification, however that is not enough to determine the entire scope of pending claim, because no actual measure of any dipole moments are recited and the term "sparingly" is therefore not defined. Furthermore it is not clear if the polar oil is the same or different in its polarity when compared to the sparingly polar oil.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 35-39, 41-50, and 60-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001 and El-Nokaly et al., U.S. Patent 5843407, issued December 1, 1998.

U.S. Patent No. 6464969 (hereafter the 969 patent) discloses in example 12 of column 16 a composition which anticipates pending claim 35. It discloses a polyethylene wax with a melting point of 83.9 °C, which is the semi-crystalline polymer, black iron oxide which is the colorant. The paragraph of line 43 of column 6 discloses that the polyethylene waxes are semi-crystalline. Note that the paragraph discloses that this polymer is a thermal transition agent. The dispersion of example 12 as well as the

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isododecane form the liquid fatty phase of this composition. The 969 patent does not disclose isononyl isononoate, the elected ester, however it does disclose in the paragraph of line 7 of column 8 that a wide variety of oils may be used, not just the isododecane of example 12. Concerning pending claims 60 and 61, example 12 of the 969 patent discloses that the semi-crystalline polymer, polyethylene wax, is present in an amount of 20% by weight, which is within the ranges of pending claims 60 and 61. Concerning the polymers and temperatures of pending claim 62-65, these are not explicitly recited by the 969 patent in a single embodiment. However the paragraph of line 46 of column 3 of the 969 patent discloses that the at least one thermal transition agent (also the film forming polymer in some embodiments) has a melting point which overlaps with the melting points of the pending claims. Furthermore the inclusion of the phrase "at least one" suggests that a combination of two or more such polymers can be used, as per the pending claims. The ranges of pending claims 66 and 67 likewise do not add patentable distinctness to the pending claims because it would have been prima facie obvious to one of ordinary skill in the art to make the modifications in these claims because the 969 patent suggests that these modifications may be made (see MPEP section 2144.5 quote, below). Concerning the elected semi-crystalline polymers; behenyl acrylate and stearyl acrylate homopolymers, the polymers disclosed in the first paragraph of column 5 of the 969 patent differ from these polymers by only one methyl group on each monomer. These polymers include behenyl methacrylate and stearyl methacrylate, and one would have been motivated to use behenyl and stearyl acrylate because the removal of the methyl group from the monomers results in a polymer which

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is structurally very similar. As such these polymers are homologs of the polymers elected in the instant application. Section 2144.09 of the MPEP states, "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). Note that example 12 of the 969 patent contains no matting filler or water, as per pending claims 72 and 73. Note that the composition is a mascara as per pending claim 75. Note that the casting of pending claim 74 is directed to a process for making the product rather than the product itself, and as such does not further define or limit the product. The examiner also asserts that the polymers disclosed in the 969 patent and the amounts they may be present in would inherently provide the hardness of pending claim 76, because waxes are known to be useful in hardening lipstick compositions, as is evidenced by U.S. Patent 4996044, lines 1-7 of column 4. Alternatively, should it be found that the hardness is not inherent, it would have been prima facie obvious to one of ordinary skill in the art to optimize the hardness of the composition. Concerning the oils of pending claim 68, see the indefiniteness rejection above and note that the 969 patent suggests the use of a multitude of different oils, as has been discussed supra. The 969 patent does not disclose the limitations of pending claims 36-39, 41-50, 69-71, 76, or 77. These limitations are addressed below.

U.S. Patent 5843407 (hereafter the 407 patent) discloses the use of isononyl isononoate (paragraph of line 10 of column 4) as a preferred oil in an emollient component system which provides adhesion, gloss, and occlusive moisturization to the lipstick (as per pending claim 77) in which it is contained (paragraph of line 31 of column 3). Note that isononyl isononoate reads on the limitations present in pending claims 36-39 and 41-42. Lines 63-65 of column 1 of the 407 patent disclose that emollient component, which is most preferably about 70% to about 90% oil (lines 40 and 41 of column 3), is present from about 1 to about 90%. Note that these ranges overlap with the ranges of pending claims 43 and 44. Section 2144.05 of the MPEP states "In the case where the claimed ranges "'overlap or lie inside ranges disclosed by the prior art' a prima facie case of obviousness exists.'" In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Concerning the ranges from pending claims, 45-50, the same section of the MPEP states, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Furthermore, the optimization of ranges by routine experimentation would lead to the same amounts because the optimization is towards the same purpose in the prior art and the instant application; to provide for a composition with an improved gloss and comfort (line 23 of page 1 of the instant specification and lines 31-35 of column 3 of the 407 patent.) Also, concerning the ranges of pending claims 49 and 50 specifically, it would have been prima facie obvious to one of ordinary skill in the art to optimize the molecular masses of these polymers. Concerning the wax content of pending claim 71, note that the wax

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amount of line 28 of column 3 of the 407 patent overlap with the range disclosed in that claim. Concerning the hardness of pending claim 76, it would have been prima facie obvious to one of ordinary skill in the art to optimize the hardness of a lipstick in order to provide it with the necessary or optimum structural integrity.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the 407 patent and the 969 patent and one would have been motivated to do so because the 407 patent discloses that isononyl isononoate is useful as the oil component of a cosmetic composition and it is therefore a suitable substitute for the isododecane of example 12 of the 969 patent and because the 407 patent discloses that isononyl isononoate is a preferred oil for use in a lipstick because of its improved glossing properties. Also, the 969 patent discloses that its composition may be used for lip products, and lipstick is an obvious lip cosmetic.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 35-39, 40-50, and 60-77 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6949504 in view of De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001 and El-Nokaly et al., U.S. Patent 5843407, issued December 1, 1998.

U.S Patent No. 6949504 (hereafter the 504 patent) claims a composition differing from the instant claims only by the inclusion of at least one volatile oil in the instant claims, and the inclusion of a second polymer in the 504 patent. One would have been motivated to add the at least ester oil by the combination of example 12 of the 969 patent and the 407 patent, discussed supra. Furthermore, one would have been motivated to include a second polymer by the 969 patent as has been discussed supra, as well as by the claims of the 504 patent, which include compositions having 2 polymers with different melting points and those melting points overlap with the melting points of instant claims 62-65. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to include the second polymer and at least one ester because the 969 and 407 patents suggests the addition of an ester and the 969 and 504 patents suggest the use of more than one semi-crystalline polymer. The addition of a colorant to a composition of this nature is

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suggested by the 969 patent, which discloses black iron oxide colorants in its example 12, discussed supra. The patent claim 1 and instant claim 35 recite overlapping melting points for the semi-crystalline polymer and in the case of overlapping ranges, a prima facie case of obviousness exists. Also, note that the instant claim melting point of at least 30 degrees Celsius reads on the patent claim language "solid at ambient temperature." Concerning the structural differences between the patent and instant polymer, it would have been prima facie obvious to substitute one semi-crystalline polymer for another, provided it had the proper melting point and the 969 patent suggests that any such polymer which is also suitable for application to this skin would be acceptable. All other modifications to the instant claims and the way in which they are obviated have been discussed supra.

3. Claims 35-39, 40-50, and 60-77 are rejected on the of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 7129276 in view of De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001 and El-Nokaly et al., U.S. Patent 5843407, issued December 1, 1998.

The instant claims differ from the claims of U.S. Patent No 7129276 (hereafter the 276 patent) only in the inclusion of a second polymer with a different melting point in the claims of the 276 patent as well as the inclusion of a colloidal dispersion of particles in the 276 patent. The addition of a second polymer in the instant claims is obviated by the 969 patent, discussed supra, as well as the 276 patent which suggests including two such polymers having different melting points. Furthermore, the addition of the

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colloidal, dispersed particles is obviated by example 12 of the 969 patent, which includes pigment particles as well as poly(methylacrylate/acrylic acid) particles. Note that because these particles are part of a dispersion, a dispersing agent is used. The addition of a colorant to a composition of this nature is suggested by the 969 patent, which discloses black iron oxide colorants in its example 12, discussed supra. The patent claim 1 and instant claim 35 recite overlapping melting points for the semi-crystalline polymer and in the case of overlapping ranges, a prima facie case of obviousness exists. Also, note that the instant claim melting point of at least 30 degrees Celsius reads on the patent claim language "solid at ambient temperature." Concerning the structural differences between the patent and instant polymer, it would have been prima facie obvious to substitute one semi-crystalline polymer for another, provided it had the proper melting point and the 969 patent suggests that any such polymer which is also suitable for application to this skin would be acceptable. All other modifications to the instant claims and the way in which they are obviated have been discussed supra.

The examiner is aware of the following pending applications which raise similar obviousness-type double patenting issues: 10/502447 and 11/147236.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pochas whose telephone number is

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(571)270-7722. The examiner can normally be reached on Monday to Friday 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CMP/

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4121